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10/656,930	09/04/2003	Geoffrey B. Rhoads	P0877	8366

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DIGIMARC CORPORATION
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EXAMINER

PERUNGAVOOR, VENKATANARAY

ART UNIT	PAPER NUMBER
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2132

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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,930

Applicant(s)

RHOADS ET AL.

Examiner

Venkat Perungavoor

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

The objection with regard to the Specification has been withdrawn in view of the amendments.

The 35 USC 112 1 \P rejection of claim 4 has been withdrawn in view of the amendments.

The 35 USC 112 2 \P rejection of claim 9 has been withdrawn in view of the amendments.

Applicant's arguments filed 8/28/2007 have been fully considered but they are not persuasive.

The Applicant has seasonably argued claims 1, 3, 8, 9-12, 14-16, 18, and 20 and the Examiner will rebut each of the claims here.

Regarding Claim 1, 12, 20, The Applicant argues that the office has failed to show reference code being used to retrieve the second authentication information and digital representation of an object. The Applicant further argues the first and second authentication information being used to determine authenticity has not been explicitly pointed. And finally, the Applicant disagrees with the motivation to combine the references.

Kodak discloses the pre-approval code being generated based on the digitized image see Col 5 Ln 34-37. And further mentions the pre-approval code being used to retrieve the validation requestor code, which is used to compare(i.e. authenticate) see Col 5 Ln 54-59. The Kodak reference mentions the first authentication(image encoded data) and the second authentication information(validation code) being used to authenticate the user Col 5 Ln 25-34 & Col 6 Ln 11-17. And finally, in response to applicant's argument

that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Claim 11, The Applicant argues the office has failed to show that a digital signature has been embedded in a graphic on the analog form.

Kodak mentions the individual appearance, signature, fingerprint being embedded as a graphic see Col 5 Ln 25-34.

Regarding Claim 18, The Applicant here again argues that the analog form includes an image in which the first authentication information is embedded.

Kodak discloses the image data being applied on a card that includes the signature, fingerprint see Col 5 Ln 6-11.

Regarding Claim 3, 15, The Applicant argues that the office has failed to show a key and the key being obtained from storage to read first authentication information.

Kodak discloses the identification code which determines the encryption algorithm to be used and is obtained from a database see Col 3 Ln 16-21.

Regarding Claim 8, 14, The Applicant argues that the PIN and authentication information are not similar.

Kodak discloses the PIN, account number, and other identification information being used to illustrate the authentication see Col 7 Ln 20-25 & Col 3 Ln 20-34.

Regarding Claim 10, The Applicant argues that the office has failed to show the reference code being used to route to another apparatuses.

Kodak discloses the routing of digital representation to the CAA to monitor and modem see Col 6 Ln 19-30.

Regarding Claim 19, The Applicant argues that the office has failed to show the reference code is the identification number of the photo ID.

Kodak discloses the photo having an ID and further being used for the stated purposes(i.e. retrieving information and authentication) see Col 2 Ln 58- Col 3 Ln 16.

Regarding Claim 9 and 16, The Applicant argues that the Cooperman references does not fill in the gaps of independent claims.

Kodak in combination with Cooperman discloses the recited invention as it can be seen from the arguments above and rejection below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-3, 5-8, 10-15, 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by EP0650146 A1 to Eastman Kodak Company(Kodak) in view of US Patent 5613004 to Cooperman et al.(hereinafter Cooperman).

Regarding Claim 1, 20, 11, 18, Kodak discloses the storage system which stores the second authentication information see Fig. 1 item 30; a processor having an information reader see item 20; and processor to retrieve second authentication information see item 50, 80 and recover the first authentication information and compare with second authentication information to determine authenticity see Abstract & Col 5 Ln 22-Col 6 Ln 10 & Col 6 Ln 5-8 & Col 11-15. But does not disclose the embedding of first information. However, Cooperman discloses the embedding of first information see Col 5 Ln 30-48. It would be obvious to one having ordinary skill in the art at the time of the invention to include in the invention of watermarking/embedding in order to make it visually imperceptible see Col 5 Ln 60-66.

Regarding Claim 2, 13, Kodak discloses the algorithm being chosen and embedded within the table and used with the code to check authenticity see Col 5 Ln 34-58.

Regarding Claim 3, 15, Kodak discloses the validation requestor identification code being sent to CAA to obtain other codes and for storage see Col 3 Ln 21-34.

Regarding Claim 4, Kodak discloses the second authentication is based on semantic information contained in the image see Col 5 Ln 1-11; the authentication information reader includes a semantic information reader and authentication information maker see Col 5 Ln 37-44.

Regarding Claim 5, Kodak discloses the authenticity of the code being verified to the source see Fig. 1 item 90.

Regarding Claim 6, Kodak discloses the digitalizing of photos see Col 3 Ln 3-7.

Regarding Claim 7, Kodak pre-approval code being used and the algorithm is being used to be verified with CAA and the card see Col 6 Ln 58- Col 7 Ln 4.

Regarding Claim 8, 14, Kodak discloses the PIN number being inputted by the user see Col 7 Ln 20-25.

Regarding Claim 10, Kodak discloses the plurality of devices and routing codes see Col 6 Ln 23-39.

Regarding Claim 12, Kodak discloses the digitalizing of photos see Col 3 Ln 3-7; further discloses the storage system which stores the second authentication information see Fig. 1 item

30; a processor having an information reader see item 20; and processor to retrieve second authentication information see item 50, 80 and read the first authentication information and compare with second authentication information to determine authenticity see Abstract & Col 5 Ln 22-Col 6 Ln 10. But does not disclose the embedding of first information. However, Cooperman discloses the embedding of first information see Col 5 Ln 30-48. It would be obvious to one having ordinary skill in the art at the time of the invention to include in the invention of watermarking/embedding in order to make it visually imperceptible see Col 5 Ln 60-65.

Regarding Claim 17, Kodak discloses the verification of visual aspects see Col 1 Ln 55- Col 2 Ln 16.

Regarding Claim 19, Kodak discloses the photo ID see Col 2 Ln 16-19, photo being scanned in photo software see Col 4 Ln 31-33, and the tagging of photos see Col 4 Ln 34-38.

Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP0650146 A1 to Eastman Kodak Company(Kodak) in view of US Patent 5613004 to Cooperman et al.(hereinafter Cooperman) further in view of US Patent 5467447 to Vogel.

Regarding Claim 9, Kodak discloses the authentication of read information see Abstract. But does not explicitly disclose analog form containing a security pattern and associating the pattern with digital representation. However, Vogel discloses the analog form containing a security pattern see Fig. 1 item 5 and 6 and associating the pattern with digital representation see Fig. 11 item 24. It would be obvious to one having ordinary skill in the art at the time of the invention to include the analog form containing a security pattern and associating the pattern with digital

representation in the invention of Kodak in order to further improve security by an texture feature see Col 3 Ln 20-30.

Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP0650146 A1 to Eastman Kodak Company(Kodak) in view of US Patent 5475205 to Behm et al.(hereinafter Behm).

Regarding Claim 16, Kodak does not disclose the locating of authentication information. However, Behm discloses the locating of the information on the document and checking for authenticity see Abstract & Col 6 Ln 15-24.It would be obvious to one having ordinary skill in the art at the time of the invention to include the information on the document and checking for authenticity in the invention of Kodak in order to have defined portion dedicated to authentication information see Col 5 Ln 13-26.

Conclusion

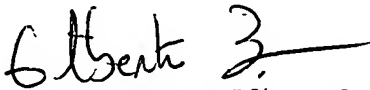
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action, and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkat Perungavoor whose telephone number is 571-272-7213. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VP/
Venkat Perungavoor
Examiner
Art Unit 2132
September 28, 2007


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